

~~(b) data.~~RESPONSE TO OFFICE ACTION

The Office Action dated August 23, 1995 has been carefully reviewed and the foregoing amendments made in response thereto. Claim 1 has been canceled and claim 82 has been amended. Claims 2-3, 5, 7-11, 13, 16-20, 22, 23, 31-40, 42, 44 and 49-84 remain active in this application.

Claims 1 and 82 stand rejected under 35 U.S.C §102(e) or in the alternative under 35 U.S.C. §103 in view of U.S. Patent No. 4,381,522 to Lambert. The rejection of claims 1 and 82 has been rendered moot by the cancellation of claim 1 and amendment of claim 82.

Claims 1-3, 5, 7-11, 13, 16-20, 22, 23, 42, 44 and 49-84 stand rejected under the judicially created doctrine of [obviousness type] double patenting in view of claims 1-13 of U.S. Patent No. 4,694,490 (the '490 patent) for the reasons set forth in paragraph 2 of paper #10, and in particular, based on In re Schneller, 397 F.2d 350, 158 U.S.P.Q. 210 (C.C.P.A. 1968).

Because the pending claims are patentably distinct from the claims of the '490 patent and because the examiner has failed to establish a prima facie case sufficient to support the double patenting rejection, applicants respectfully request that the examiner withdraw the double patenting rejection.

**I. THE TEST FOR OBVIOUSNESS-TYPE DOUBLE PATENTING
REQUIRES A COMPARISON OF THE CLAIMS**

The examiner states in paper # 10 that a double patenting rejection is appropriate because the subject matter of the pending claims "was fully disclosed" in the '490 patent. That statement is wrong. To prevent unjustified extension of patent right beyond statutory limits, the doctrine of obviousness-type double patenting permits the rejection of application claims to subject matter different but not patentably distinct

from the subject matter claimed in a prior patent. In re Goodman, 11 F.3d 1046, 1052, 29 U.S.P.Q. 2d 2010, 2015-16 (Fed. Cir. 1993) (citing In re Braat, 937 F.2d 589, 592, 19 U.S.P.Q. 2d 1289, 1291-92 (Fed. Cir. 1991)). However, the only issue in an obviousness-type double patenting rejection is whether any claim in the application defines a merely obvious variation of an invention disclosed and claimed in the patent relied on for the rejection. In re Vogel, 422 F.2d 438, 441, 164 U.S.P.Q. 619, 621-622 (C.C.P.A. 1970); General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1278, 23 U.S.P.Q. 2d 1839, 1843-44 (Fed. Cir. 1992). Stated differently, "we must direct our inquiry to whether invention of the application for the second patent would have been obvious from the subject matter of the claims in the first patent, in light of the prior art." In re Longi, 759 F.2d 887, 892 (Fed. Cir. 1985).

Contrary to the examiner's statements in paper # 10, the mere disclosure in the patent specification of the subject matter of the application claims does not support a double patenting rejection because the "comparison can be made only with what invention is *claimed* in the earlier patent. . ." General Foods, 972 F.2d at 1280, 23 U.S.P.Q. 2d at 1845 (emphasis original). In comparing the claims of the specification to those of the earlier patent, "it must always be carefully observed that the appellant's patent is not 'prior art' under either section 102 or 103 of the 1952 Patent Act (35 USC, as amended)." In re Boylan, 392 F.2d 1017, 1018, 157 U.S.P.Q. 370, 371 n. 1 (C.C.P.A. 1968).

II. IN RE SCHNELLER DOES NOT SUPPORT THE DOUBLE PATENTING REJECTION OF APPLICANTS' CLAIMS

To support the double patenting rejection, the examiner relies principally upon In re Schneller, 397 F.2d 350, 158 U.S.P.Q. 210 (C.C.P.A. 1968). Schneller is inapposite to this case and does not support the double patenting rejection. The court in Schneller affirmed the U.S. Patent Office Board of Appeals' (the Board's) ruling affirming the examiner's rejection of application claims 17-23 for double patenting over Patent No. 2,945,329 (the '329 patent), which is related to the application. In Schneller, the '329

patent claimed an improved clip comprising old elements A, B, C (shown together in the prior art) and new element X. The application claimed a clip comprising old elements A, B, C, and new element Y. The preferred embodiment of the clip, as disclosed in the '329 patent and the application, included elements A, B, C, X and Y. The Court in Schneller held that the invention A, B, C, Y claimed in the application was not patentably distinct from the invention A, B, C, X claimed in the patent and affirmed the double patenting rejection.

As stated by the Court in Schneller, the fundamental reason for the rule against double patenting is to prevent unjustified timewise extension of the right to exclude granted by a patent. Schneller, 397 F.2d at 354, 158 U.S.P.Q. at 214-15. The Court in Schneller applied a traditional double patenting analysis and considered first whether the application claims, if allowed, would extend the patent rights granted in the '329 patent, and second whether such an extension of patent rights (if present) was justified.

Regarding whether the application would extend patent rights of the '329 patent, the court agreed with the appellant that the two claimed inventions were not the identical or same invention. The court stated, "[t]rue, there is no double patenting in the sense of claiming the same invention because ABCX and ABCY are, in the technical patent law sense, different inventions." Schneller, 397 F.2d at 354, 158 U.S.P.Q. at 214. Thus, a same invention type double patenting rejection under 35 U.S.C. § 101 was not applicable. In re Vogel, 422 F.2d 438, 441, 164 U.S.P.Q. 619, 621-22 (C.C.P.A. 1970). Next, after considering the appellant's argument, the court concluded that the claimed invention of the application was not patentably distinct from the invention claimed in the '329 patent, stating, "[h]ere, appellant has clearly not established the independent and distinct character of the inventions of the appealed claims." Schneller, 397 F.2d at 354, 158 U.S.P.Q. at 215.¹ Because the application claims were not patentably distinct

¹ A double patenting rejection based on a finding that the claimed inventions of the application and patent are not independent and distinct is commonly known as an obviousness-type double patenting rejection. In re Braithwaite, 379 F.2d 594, 599-600, 154 U.S.P.Q. 29, 33-34 (C.C.P.A. 1967). The basis of an obviousness-type double patenting rejection is that the difference between the subject matter of the

from the claims of the '329 patent, the court, therefore, found that "patent protection for the clips, . . . would be extended by the allowance of the appealed claims." Schneller, 397 F.2d at 355, 158 U.S.P.Q. at 215.

While the application claims in Schneller, if allowed, would have extended patent protection, the court next considered whether such a patent extension was justified nonetheless. The court in Schneller concluded that a patent extension was not justified because a restriction requirement under 35 U.S.C. § 121 was not present, the two inventions (ABCX and ABCY) were not invented by two separate inventors, or other mitigating circumstances were not present making it equitable to allow the claims without a terminal disclaimer.² Schneller, 397 F.2d at 355, 158 U.S.P.Q. at 215-16.

Schneller holds that two separate patents may not issue on patentably indistinct inventions, absent some mitigating circumstances favoring an extension of patent right. Any language in the Court's opinion that could be construed otherwise is merely dicta and is contrary to previous and subsequent case law. Schneller is inapplicable to the present case because the claims under examination in this case are patentably distinct

application claims and the patent claims would have been obvious to one of ordinary skill in the art in view of the prior art. Id.

² In obviousness-type double patenting rejections, the extension of protection objection is not necessarily controlling. In re Braat, 937 F.2d 589, 593, 19 U.S.P.Q. 2d 1289, 1292 (Fed. Cir. 1991). There are at least three situations where courts have permitted a timewise extension of patent right: (1) Double patenting is excused where a divisional application was filed in response to a restriction requirement. 35 U.S.C. § 121. (2) When a later filed improvement (species) patent issues before an earlier filed basic invention, a double patenting rejection is only proper against the claims to the basic invention if the improvement is not patentably distinct from the basic invention (requiring a two-way patentability analysis). The rationale behind this exception is that an applicant who files basic and improvement patents should not be penalized by the rate of progress of the applications through the PTO, a matter over which the applicant does not have complete control. Braat, 937 F.2d at 593; 19 U.S.P.Q. 2d at 1292; In re Borah, 354 F.2d 1009, 148 U.S.P.Q. 213 (C.C.P.A. 1966). (3) Courts have also required a two-way patentability analysis to sustain a double patenting rejection as between applications involving different inventive entities that are commonly assigned. The reason for this exception is that each inventive entity may have developed and disclosed separate subcombinations, and thus, all the subcombinations could not have been included in a single application. See Braat, 937 F.2d at 593-594, 19 U.S.P.Q. 2d at 1293 (court stated that "Philips could not have included the claims of Dil in the Braat application, for Braat did not invent the subject matter of the Dil Claims. . .") See also, In re Stanley, 214 F.2d 151, 102 U.S.P.Q. 234 (C.C.P.A. 1954); Kaplan, 789 F.2d 1574, 1577, 229 U.S.P.Q. 678, 680-81 (Fed. Cir. 1986). Compare In re Longi, 759 F.2d 887, 225 U.S.P.Q. 645 (Fed. Cir. 1985) (double patenting rejection affirmed involving applications from different inventive entities that were commonly assigned).

from the claims of the '490 patent and, thus, no extension of patent right is involved. While the disclosure in the '490 patent of the subject matter claimed in the present application might be relevant to whether an alleged extension of the '490 patent rights would be justified, such disclosure in the earlier patent is not relevant to whether the claims of the present application are patentably distinct from the claims of the earlier patent (i.e., whether the application claims extend patent rights granted in the '490 patent).³ Applicants are not seeking to justify an extension of patent rights of the '490 patent because the application claims do not involve an extension of rights.

III. THE PENDING CLAIMS ARE PATENTABLY DISTINCT FROM THE CLAIMED SUBJECT MATTER OF THE '490 PATENT

The examiner's conclusion at page 3 of paper # 10 that "...patent protection for the device, fully disclosed in and covered by the claims of the patent, would be extended by the allowance of the claims in the application, " is unsupported and untrue. As in In re Kaplan, the examiner in this case "...must inquire more closely. . . extension of what patent right?" In re Kaplan, 789 F.2d 1574, 1578, 229 U.S.P.Q. 678, 681 (Fed. Cir. 1986). In this case, the examiner did not attempt to compare the pending claims to the claims of the '490 patent as required for a double patenting rejection. Allowance of the pending claims would not involve an extension of the patent rights granted in the '490 patent because the application claims are patentably distinct from the claims of the '490 patent.

As discussed in applicants' response dated May 11, 1995, claims 1-13 of the '490 patent relate to a method/apparatus for communicating programming to a plurality of stations, and generating and displaying a user specific overlay that is related to the received programming. The user specific overlay is generated and displayed in

³ If the subject matter claimed in the present application had not been disclosed in the '490 patent, this might be a mitigating factor justifying an extension of the '490 patent rights, since the application claims could not have been included in the '490 patent. See Braat, 937 F.2d at 593-594, 19 U.S.P.Q. 2d at 1293. However, whether or not the subject matter of the application claims was disclosed in the '490 patent is not relevant to whether the application claims are patentably distinct from the '490 patent claims.

response to the receipt of a signal. In this manner, a display is presented that includes the television programming and the user specific computer generated overlay.

In contrast, all of applicants' pending claims are directed to apparatus or methods for controlling the communication of television programming to a subscriber and includes a number of claimed features that are different from those claimed in the '490 patent. For example, all of applicants' claims (except claims 10, 13, 16, 18 and 19) include the communication of a unit of television programming according to a programming schedule. The programming schedule may designate, for example, a time or channel for communicating the unit of programming. Also, applicants' pending claims 10, 13, 16, 18 and 19 are directed to a method of controlling the communication of television programming from a television programming source to a subscriber, and include the steps of receiving programming units from a remote source, loading a plurality of prerecorded units of programming onto a local programming source, receiving a plurality of signals from a remote source, each signal designating one unit of said loaded units or said received units, identifying the unit designated by each control signal, and communicating the identified unit.

Accordingly, it is respectfully submitted that none of applicants' claims are obvious in view of the subject matter of claims 1-13 of the '490 patent. General Foods, 972 F.2d at 1278, 23 U.S.P.Q.2d at 1843; Vogel, 422 F.2d at 441, 164 U.S.P.Q. at 621.

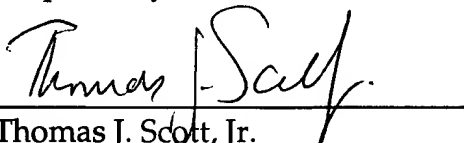
IV. THE EXAMINER HAS FAILED TO ESTABLISH A PRIMA FACIE CASE TO SUPPORT AN OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION

As with any rejection based on art, the PTO has the burden of establishing a prima facie case of obviousness-type double patenting. Longi, 759 F.2d at 895, 225 U.S.P.Q. at 650; compare, In re Piasecki, 745 F.2d 1468, 1471-1472, 223 U.S.P.Q. 785, 787-788 (Fed. Cir. 1984). The analysis for an obviousness-type double patenting rejection is analogous to the analysis for a rejection for obviousness under 35 U.S.C. § 103. Longi, 759 F.2d at 892 n. 4, 225 U.S.P.Q. at 648 n. 4. The double patenting analysis is not

identical to the § 103 analysis because the patent principally underlying the double patenting rejection is not prior art. Id. In determining whether claimed invention of the application would have been obvious from the subject matter of the claims in the first patent, in light of the prior art, "there must be some clear evidence to establish why the variation would have been obvious which can properly qualify as 'prior art.'" Kaplan, 789 F.2d at 1580, 229 U.S.P.Q. at 683. "Even if obviousness of the variation is predicated on the level of the skill in the art, prior art evidence is needed to show what the level of skill was." Id. If the examiner fails to sustain his burden of establishing a prima facie case of obviousness-type double patenting, then the rejection will not stand and a patent must issue. Id.

In this case, the examiner has not presented any evidence to support the double patenting rejection. Moreover, as discussed above, clear differences exist between the claimed subject matter of the application and the claimed subject matter of the '490 patent. Having failed to provide any evidence of obviousness, the examiner has not met his burden of establishing a prima facie case of obviousness-type double patenting and the rejection cannot stand.

Respectfully submitted,



Thomas J. Scott, Jr.
Reg. No. 27,836

Date: November 15, 1995